

TRADEMARKS FOR ENTREPRENEURS

WHAT IS A TRADEMARK, AND HOW DO YOU GET ONE
WITH SECRET LAWYER TIPS AND ILLUSTRATIONS ENCLOSED



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WARNING: Registering a trademark is a legal process. Do not detrimentally rely on this book for legal advice. This book is written simply to overview the trademark process, but does not, by any means, offer a full scope of trademark law. There may be aspects of the trademark process that are not included in this book, but that are vital in order for you to get a trademark. Following the process set out in this book does not in anyway guarantee that you will succeed in getting a trademark

Is This Trademark Ebook Guide the Right Book for You?

As a small business owner of a law firm, I am a major “do-it-yourselfer.” Yes, I understand the urge to file a trademark on your own, and so this ebook will tell you what you need to know in order to do just that.

This is a compact offering of the trademark procedures you can take for your business, blog or brand, along with indispensable, easy to consume information about trademark laws. Before we begin, the phrase “get trademarked” as used throughout this book means the process of getting your mark registered as a trademark with the United States Patent and Trademark Office. Please note that this United States Patent and Trademark Office will be referred to as the “USPTO.”

We understand that going to the USPTO website to file your own trademark can be overwhelming. Where do you start? What all do you need to know in order to get a trademark registered? Here are the 10 things you absolutely must know and do, to successfully get trademarked.

- STEP # 1**
LEARN WHAT A TRADEMARK IS
- STEP # 2**
LEARN WHY YOU REGISTER A TRADEMARK
- STEP # 3**
LEARN WHAT IS REQUIRED OF A MARK TO HAVE IT REGISTERED
- STEP # 4**
SEARCH FOR AVAILABILITY OF YOUR TRADEMARK
- STEP # 5**
ASSESS WHETHER YOU HAVE A DESIGN OR STANDARD MARK
- STEP # 6**
IDENTIFY ALL OF THE GOODS OR SERVICES OF YOUR BUSINESS
- STEP # 7**
FIGURE OUT YOUR "BASIS FOR FILING" THE APPLICATION
- STEP # 8**
PREPARE TO UPLOAD A DRAWING AND A SPECIMEN
- STEP # 9**
USING THE ABOVE, FILL OUT THE APPLICATION
- STEP # 10**
PAY THE \$275+ IN FEES AND SUBMIT



What is a Trademark?

Trademarks are symbols of identification. Do you know how your fingerprint is your own unique mark, and no other finger is identical to yours? Well, that is what

your trademark is for your business. No one can have the same mark for your trade as you can. I say, “mark for your trade” because your trademark is going to keep others in the same trade or industry from copying. A service mark is just like a trademark only it is a mark that represents a *service* based business. The laws that apply to servicemarks also apply to trademarks. *The two words are interchangeable for the purposes of this ebook.*

Here are some very famous trademark examples:



Because these trademarks are famous, you know what business they stand for, without us telling you. Trademarks can be pictures of characters you use for your business, such as the Pillsbury Dough Boy. Trademarks can be **color combinations**, slogans like Nike’s “Just Do it,” or even sounds. *You might not have a traditional logo for your business, but that does not mean you do not have something worth trademarking.*

In fact, I would venture to say that *every* successful business has something worth trademarking. Here is a less known very clever trademark for a bakery, called “The Makery.” You know that this is a registered trademark because of the little “R” in the upper righthand corner:



The tiny circled “R” means it is registered with the USPTO. Using the “R” when the symbol is not registered is *illegal*.



One way to understand the scope of a trademark is to know what a trademark is *not*. A trademark can be artistic, but this does not mean that all works of art can be trademarked. When you apply for a trademark, you have to say what business or organization the trademark represents. If it does not represent a business or organization, it likely cannot be trademarked, but instead has to be *copyrighted*. Here is an example of something that is not a trademark, but instead is a work of art that can be copyrighted¹:



Paintings like the one above, ebooks like this one, songs, or book titles are creative works that can be protected by copyrights, but not as trademarks. Now, of course, if a business was to start using the above painting scene as its branding *identity*, then that would make this painting something to trademark. In other

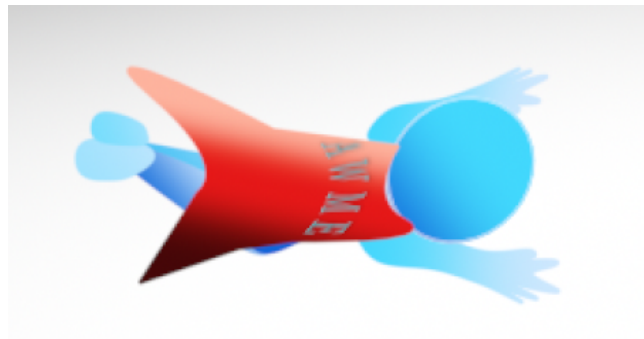
¹ In fact, this work of art *is* copyrighted, and so we bought the ability to use this picture from bigstock.com

words, the *use* of the work makes the difference as to how it may be federally protected as intellectual property.

There are three different types of trademarks including standard characters (words without fonts specified), sound and special form. Here are some examples of possible special form (also called “design”) trademarks:



The Company, AudienceWatch.me has given us permission to talk about it as an illustrative example. AudienceWatch.me could technically attempt to trademark several identifying aspects of its business. It could file a trademark to register its host character, “Awme” by just trademarking the term, or by trademarking the designed character, as illustrated below:



The company could also attempt to register trademarks for its slogans: “the most creative content in the world,” “finally the site to find creative content” and “for content that says Audience you have to watch me.” The point here is that a business should assess what parts of its identity need to be federally registered and protected; The traditional logo is not the *only* thing to consider. I hope you now know what a trademark is. I hope you are easily picturing the trademarks of your company.

Why Have a *Registered* Trademark?

If you have a logo that you are using in your business and it is not registered, then please understand that you already have a trademark. You just have not registered it yet. Trademark registration is merely the legal process of filing your trademark

with the United States Patent and Trademark Office for the purposes of preserving your ownership of the mark.

Building a company without a registered **Trademark** is like building a house on a property that's not yours.

I have to offer this piece of general advice to all companies; *Yes you should register your trademark(s).* If you have put this energy into starting a business, then you must believe in it. Why not believe in it enough to protect its identity, and make sure that no one else can come along, steal your business identity and sell things due to your outstanding efforts. Look at it this way; If you wait until your company is successful enough in your eyes to have a trademark, then it may be too late because success gets copied. If enough copycats get their similar marks registered, your mark's value will be diluted and diminished.

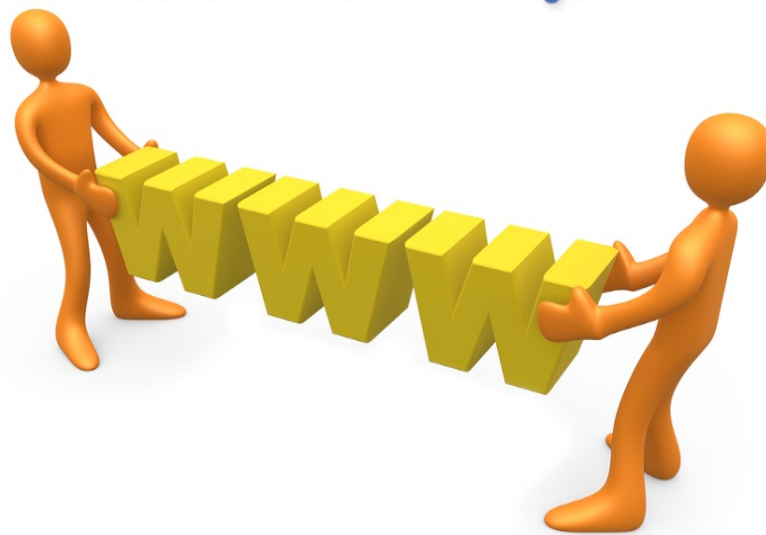
If you are wondering whether it is farfetched to believe whether someone would steal a trademark, allow me to tell you this story:

A company had a catalog called "Sporty's" that targeted aviation enthusiasts. This Company properly owned the trademark "sporty's." A guy subscribed to Sporty's magazine. The guy was a company owner. The guy's company, knowing about Sporty's catalog, bought the domain name sportys.com, and through a sequence of business dealings, went into competition with the Sporty's catalog company. Ultimately the Sporty's catalog Company won its lawsuit against the infringing company. Without a registered trademark, it would have been more difficult for Sporty's to protect itself. Today, you will see that the original catalog owner has control over the sportys.com URL because of this lawsuit, and because of its trademark protection.



This Sporty's story should teach you two things: 1. You should have a trademark registered; and 2. Domain name copying can result in trademark litigation. Thus, you should not buy your domain name without professionally researching registered trademarks. We will teach you about doing this research a little bit later. Chances are that you already have a domain name registered. Not to worry, we all make that mistake. There are many circumstances when using a domain name that is another company's name is not illegal. For instance, if your domain name is not being used for commercial purposes, this would be fine. Or, if your domain name is for a different industry than the company with the same name, this would also be (most of the time) okay. If you are very concerned, call a trademark lawyer for a consultation.

Registering a Domain Name that is Trademarked Can Be Trademark Infringement



More Reasons to Register Your Mark

Besides reducing the lingering threat of illegal infringers, trademarks offer additional value. Registered trademarks give a company the exclusive right to own its visual identity. They also help consumers distinguish one company from another. If consumers have a good experience with one company, then the next time, the consumer can locate and purchase from that same company because of its memorable identity. Once you register your trademark, it is true that no one can legally copy it for use as a trademark, but a trademark gets more than just that. With a registered trademark, *you are protected against anyone using a mark that*

is close enough to your mark that someone would be likely confused by the ownership of the two.



Trademarks Protect against Confusingly Similar Copies

In other words, if you own the Ford trademark, no one is going to get away with making a “Dord” trademark, and claiming Dord was not registered and was thus fair game. The rule, in its simplest form, is that trademarks cannot be so similar that consumers are left confused. This is called the likelihood of confusion test.



In addition to preventing the copying, *a trademark is a valuable asset which increases the resale value of a company.* A trademark can be bought and sold in its own right. Additionally, a company can advertise, in distinct and memorable ways, using trademarks.

McDonald's is so well known for its trademark colors, yellow and red, that it was able to put out a billboard, without any symbols aside from color to advertise its fast food.



McDonald's used only trademark colors on this billboard, without a single symbol or word

The Trademark Academic, J Thomas McCarthy eloquently wrote:

“Both consumer and producer would fare badly in a world without the distinguishing function served by trademarks....Without some such means of product identification, informed consumer choice, and hence meaningful competition in quality, could not exist.”²

Trademark registration assures that if someone infringes McDonalds' mark, the company can sue in federal court. This is a powerful protection tool to have.



The classic form of trademark infringement damage is when a trademark is similar to another, and a customer buys something from one company, believing it to be the thing from another, more reputable company. Having a trademark registered will often prevent this from occurring. Certainly, if it does occur, the trademark

² McCarthy On Trademarks and Unfair Competition, J. Thomas McCarthy, chapter 3-12.1

owner will be able to bring a lawsuit against the infringer for damages. At this point, I am hoping you know enough about trademarks to feel confident that getting your trademark registered is a good investment to make.

But, What Happens if I Do Not Register My Trademark ?

Quite importantly, a person with a non-registered trademark *still* has substantial common law rights to use established marks and to exclude others from using them. It is important for you to use “TM” or trademark on your symbols that are not registered. This will serve to educate the public that this is the identity you use for your business. The use of “TM” will also potentially prevent infringers.



What Must a Symbol Include In Order to Become a Registered Trademark

As you may have guessed, not all words, sounds or slogans can become registered trademarks. The trademark as a whole must indicate to its audience that it is the symbol of the business it originates from. For example, a bank company once tried to get a trademark for the slogan “Think About It,” and the court determined the familiar phrase could not be a trademark because the audience would not view the words as signifying the bank company itself.³

When a phrase is used simply to advertise a product, rather than to actually symbolize a company, the phrase cannot be trademarked. An applicant was rejected when he tried to get a registration for the phrase “We make it, You bake it.” The phrase was viewed as promotional material for the grocery store, rather

³ McCarthy On Trademarks and Unfair Competition, J. Thomas McCarthy, chapter 3-7,3-8 (provided the examples set forth in this section of the ebook)

than a mark that was representative of the company itself. Conversely, the phrase “Bumper to Bumper Car Care” was deemed suitable for registration for an auto parts company. That said, the way in which the trademark is *used* in the business significantly affects the ability to register the mark. As you can see, the trademark does not need to have the actual company name included.

In summary, in order to get a trademark:

- Your symbol must not be registered by someone else in the same or similar industry;
- Your symbol must not be used by someone else who does not have registration in the same or similar industry;
- Your symbol must be used in your business as an identifying mark for the company as a whole, and not just as a promotional line;
- Your symbol must be unique and not too common or familiar;
- Your symbol must either be a made-up word for your business, or a commonly used word (or words) used in a unique way; and
- Your symbol must not merely describe the service or goods it represents.

In order for the United States to require a minimal level of class and integrity, some things cannot become registered trademarks:

- Your symbol must not be immoral;
- your symbol must not be a national symbol;
- your symbol must not be designed so as to embarrass another person or company;
- your symbol must not depict a person living (without consent);
- your symbol must not be of a president, while his widow lives (without her consent);
- the words of your trademark cannot lie (no registering “OrganiK” on a product that is not actually organic).

Under this rule against immoral trademarks, the following trademarks were denied:

- Fuku (restaurant);
- Messiah wine;
- Libido (perfume);
- Week-end Sex (magazine).

More Detailed Explanation of Trademark Requirements

The term “Google” is more easy to get trademarked than the term “sock” because Google is a made-up word just for purposes of representing the search engine company. Words like Google are called “fanciful marks” in the trademark world, and are considered the strongest types of marks because *the symbol exists in the world for the sole purpose of signifying the business*. On the other hand, symbols that describe the business itself are more difficult to protect.

If you are a corn company, and your company is called yellow corn, this will not be easily protected in trademark law or registered as a trademark. Yet, if you are a corn company, and your company is called “sheep,” this would be easy to trademark because despite the fact that the word sheep is common english, the association of sheep with a corn company is unique. In sum, your trademark has to be something *special*. **It should not just describe your business in a way that other people describe other businesses.** If your trademark does just describe your business, then the only way to get it protected by trademark law is if you can prove the audience will see your mark and will know that the mark is denoting you as the only seller or source. Two descriptive, not so creative, marks that *could not* be trademarked are Raisin-bran (the bran cereal with raisins in it) and Bed & Bath (for Bed Bath and Beyond).

*If you go online and look at Kellogg’s Cereal, Frosted Flakes, you will see the tiny R, indicating registration, but no such R appears near the Raisin Bran.

Made up words like "Google" = Strong
Descriptive words like "Yellow Corn" = Weak
The stronger the trademark, the better

Maybe you thought it would be easy to get around this trademark uniqueness requirement by coming up with a business name that slightly modifies the spelling of a normal word in your business. This is a super common phenomenon happening in the world of \$12.99 domain name purchases. Examples of this include URLs such as tirebizzness.com and reevIEWS.com. *In the trademark world, just because the name is spelled wrong does not mean it is a unique mark!* Again, you have the strongest trademark if you just make up a word, rather than modifying the spelling of a normal word. Likewise, *abbreviations* that just describe

your business instead of being unique in their own right, will not get the level of protection that fanciful marks receive.

The Steps to Follow

Now, we are beginning the portion of the book where we tell you how to get trademarked. However, the best advice any book could offer on this subject is that you spend time reading the invaluable sources on USPTO.gov.

Conduct a Search

You will have to search to make sure the proposed trademark is available. Available means your mark is not identical to, or close to another mark in your industry. A search should be conducted of:

- pending federal applications;
- issued federal applications;
- state registrations; and
- very importantly, *use of non-registered trademarks* within the U.S.



Searching for trademark availability is an art, not a science. When you check for domain name availability, you get to find out if there is a person out there that already owns the exact domain. You type in the proposed domain, and the search is over. This is not the case with trademark searches. Rather, you must get into the mind of the USPTO examining attorneys. The lawyers at the USPTO will examine your proposed mark, and will then look for any other marks in the same or similar industry. The lawyer will look to see if your mark, coexisting with any other

mark, will confuse consumers. Exact matches are unacceptable, but that is only the *beginning* the search.



To start your trademark search, go online to the [USPTO](http://uspto.gov). Here You will see this:

uspto.gov
The United States Patent and Trademark Office
an agency of the Department of Commerce

search for patents | search for trademarks
Search our site [GO]

PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

Home Page » TRADEMARKS

Trademarks Home

WARNING: Non-USPTO Solicitations May Resemble Official USPTO Communications
Be aware that private companies **not** associated with the USPTO often use trademark application and registration information from the USPTO's databases to mail or e-mail trademark-related solicitations (samples of non-USPTO solicitations included).

First-Time Filers, Start Here

NEW FILERS trademark basics
View How-To Videos, FAQs, the Basic Facts Booklet, processing timelines and the ID Manual

Tools

TESS search trademarks
Search pending and registered marks using the **Trademark Electronic Search System (TESS)**.

TEAS file forms online
File applications and other documents online using the **Trademark Electronic Application System (TEAS)**.

TSDR check status & view documents
Check the status of an application and view and download application and registration records using **Trademark Status and Document Retrieval (TSDR)**.

ASSIGN assignments
Transfer (assign) ownership of a mark to another entity or change the owner name and search the **assignments database**.

TTAB trademark trial & appeal board
Visit the **Trademark Trial and Appeal Board (TTAB)** online.

DASHBOARD
Visit the **Trademark Dashboard** for Trademark Operation performance measurements.

Trademark Educational Outreach Program

Educational OUTREACH PROGRAM
Request a live presentation on trademark basics

SelectUSA
The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation, and commercialization of new technologies. The USA offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to encourage, facilitate, and accelerate business investment. To learn more about why the USA is the best country in the world to develop technology, manufacture products, and grow your business, visit SelectUSA.gov.

System Availability

Highlights

FACTS
BASIC FACTS ABOUT TRADEMARKS

TMIN
TRADEMARK INFORMATION NETWORK

TMRT
TRADEMARK REGISTRATION TIMELINES

TMFAQs
TRADEMARK FREQUENTLY ASKED QUESTIONS

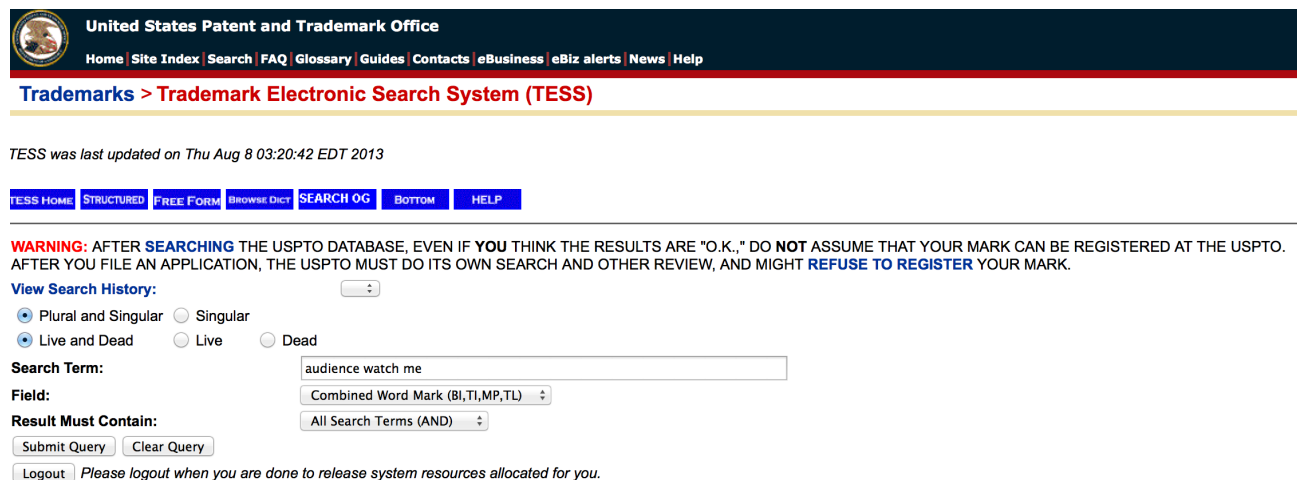
TEASFAQs
TRADEMARK ELECTRONIC APPLICATION SYSTEM FREQUENTLY ASKED QUESTIONS

Popular Links

- Documents for Prosecutors
- Fee Information
- International Registration/Madrid Protocol
- Maintain or Renew Registrations
- Trademark Manual of Examining Procedure (TMPEP)
- User Feedback
- Initiatives and Events

You will then go to the gray button near the top that says “[TESS](#).” You will have the opportunity to pick between [three options](#): “Basic Word Mark Search; Word and/or design mark search (structured); Word and/or design mark search (free form).”

Taking the Basic Word Mark Search first, we will enter our selected trademark words. Take for instance a company we did a search for called “audiencewatch.me.” We entered the business name, Audience Watch Me, and clicked the radio buttons “Live and Dead” along with “Plural and Singular,” in order to create the broadest search, as shown below:



United States Patent and Trademark Office

Home Site Index Search FAQ Glossary Guides Contacts eBusiness eBiz alerts News Help

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Thu Aug 8 03:20:42 EDT 2013

TESS HOME STRUCTURED FREE FORM BROWSE DICT SEARCH OG BOTTOM HELP

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT [REFUSE TO REGISTER](#) YOUR MARK.

View Search History: [button]

☒ Plural and Singular ☐ Singular

☒ Live and Dead ☐ Live ☐ Dead

Search Term: audience watch me

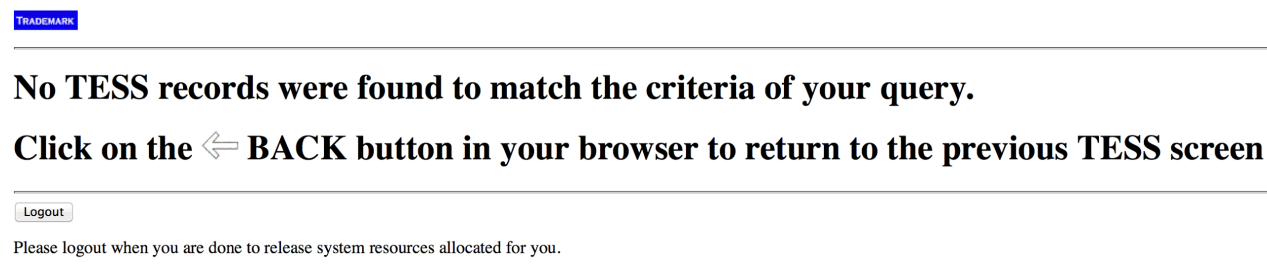
Field: Combined Word Mark (BI, TI, MP, TL) [dropdown]

Result Must Contain: All Search Terms (AND) [dropdown]

Submit Query Clear Query


Logout Please logout when you are done to release system resources allocated for you.

When we do this search, we are told that there are no other registered marks with this window:



TRADEMARK

No TESS records were found to match the criteria of your query.

Click on the  BACK button in your browser to return to the previous TESS screen

Logout

Please logout when you are done to release system resources allocated for you.

At this point, we know that no one has registered the trademark “audience watch me.” Yet, the search has only *begun*. Now, we must change our radio buttons to see if there are other marks that are close enough to this mark’s wording that the USPTO is likely to deny the mark regardless of the lacking identical copy.

Now, instead of using the button, “All Search Terms (AND),” we will use the radio button “Any Search Terms (Or)”. This way, *all* of the trademarks that have any of the terms audience, watch or me will come up. When we do this, over 20,000 results appear:

Start List At: OR Jump to record: **20273 Records(s) found (This page: 1 ~ 50)**

Refine Search Submit

Current Search: S4: docs: 20273 occ: 45319

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	86028063		ME GUSTA FEST	TSDR	LIVE
2	86025242		MEDIWATCH	TSDR	LIVE
3	86025010		AQUAFINA FLAVORSPLASH COLOR ME KIWI	TSDR	LIVE
4	86024442		AA	TSDR	LIVE
5	86024223		METHINKS	TSDR	LIVE
3	86023902		BIRDIEME	TSDR	LIVE
7	86027915		NOTICE WATCH	TSDR	LIVE
3	86027169		DIP ME IN HONEY AND FEED ME TO THE BEARS	TSDR	LIVE
9	86027157		SEND ME BACK	TSDR	LIVE
10	86027008		COOL ME DOWN BY KILIAN	TSDR	LIVE
11	86026972		RIMMEL WAKE ME UP	TSDR	LIVE
12	86026879		EQUALS ME	TSDR	LIVE
13	86026725		SPIKE ME!	TSDR	LIVE
14	86026567		GRAPHICAL LIVE WATCH	TSDR	LIVE
15	86026108		WTF BRAIN, DO YOU LOVE ME?	TSDR	LIVE
16	86025552		ZEN WATCH	TSDR	LIVE
17	86023182		AUDIENCEBLOOM	TSDR	LIVE
18	86023014		YOU HAD ME AT SAT NAM	TSDR	LIVE
19	86025523		U-ME	TSDR	LIVE
20	86025518		UNIVERSAL ME	TSDR	LIVE
21	86025295		CAR ME	TSDR	LIVE
22	86022513		VIPME	TSDR	LIVE
23	86022214		STOP, WATCH, ENROLL	TSDR	LIVE
24	86022187		IT STARTS WITH ME	TSDR	LIVE
25	86022177		IT STARTS WITH ME TECHNOLOGY SOLUTIONS	TSDR	LIVE
26	86022101		CAN'T FOOL ME!	TSDR	LIVE
27	86021081		GOD AND ME TRUE ADVENTURE STORIES	TSDR	LIVE
28	86020498		TICKLEMETHINK	TSDR	LIVE
29	86020417		INTEGRATIVE ME	TSDR	LIVE
30	86020059		TUNME	TSDR	LIVE
31	86020008		TUNEME	TSDR	LIVE
32	86019824		YOGOME	TSDR	LIVE
33	86019818		YOGOME	TSDR	LIVE
34	86018910		KNOW ME	TSDR	LIVE
35	86019661		GET SWIGGY WITH ME	TSDR	LIVE
36	86018865		GIVE THROUGH ME	TSDR	LIVE
37	86018180		HELP ME S.O.S.	TSDR	LIVE
38	86018125		TEENLOVEME	TSDR	LIVE

Clearly, we could not analyze 20,000 results; So we refine the search to phrases that might be too similar to ours. I searched “Audience Watch” and found the below single result:

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